

### Remarks

Claims 1-3 and 5-16 are pending. Claims 1-4 and 7-15 are presently rejected under §102 (b) as anticipated by U.S. Patent No. 6,497,361 to Mason (hereinafter "Mason"). Claims 5-6 and 16 are presently rejected under 35 USC §103 as obvious over Mason.

In response, Applicant has amended claim 1 to include the limitations of claims 5 and 7 and to include further distinctions. Claims 5 and 7 has accordingly been cancelled. Claim 16 has similarly been amended to include further distinctions.

### Claims 1 and 16

#### Claim Rejections- 35 USC § 102

10. Claims 1-3, 7 and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Mason (US 6,497,361). Mason discloses a customer self-checkout system for processing article purchases of articles normally having a security tag attached thereto, the system comprising: a self-checkout station 12 comprising: an input device 38 configured to receive product code input designating an article for purchase; a deactivation device 42 configured to produce a deactivation region affecting deactivation of a security tag 86 attached to an article for purchase; and a prompting system 24, 34 configured to present a deactivation prompt to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation, wherein the prompting system is configured to present the deactivation prompt after the receipt of the product code by the input device.

The Examiner's rejection is respectfully traversed. As an initial matter, Applicant is highly appreciative that the Examiner pointed out, by figure number, what parts of Mason's disclosure contains art that the Examiner believes anticipates every element of Applicant's claims.

The Examiner cited Mason for a "prompting system is configured to present the deactivation prompt after the receipt of the product code by the input device" due to the disclosure in Mason that "In another embodiment, the customer manually moves the item from the *itemization* area to the *itemized* area, prompted as necessary by touch-screen display 24 and speaker 34." Mason, Col. 4, lines 16-19.

In response, Applicant has further amended claims 1 and 16 to include the limitation “wherein the prompting system is configured to present the deactivation prompt after the receipt of the product code by the input device and prior to deactivation of the article.” Applicant suggests that Mason does not have the interactive prompting system of Applicant’s invention.

Mason discloses a system having (1) an *itemization* area and (2) an *itemized* area. Note that the names of the two areas are very similar, but they are not the same location. The actions of (a) bar code scanning, and (b) tag deactivation *both* happen in the itemization area. See Mason, column 3, lines 16-52. If the item has no bar code, the user enters item codes when the products are within the itemization area, after which the items are deactivated in the itemization area. See Mason, column 3, lines 56-66. **In either case, there is no movement from scanning/identifying to deactivation and no prompting is done between these steps.** The items are then moved from the itemization area to the itemized area for bagging. See Mason, column 2, lines 37-44. Since both bar code scanning and tag deactivation happen in the same “itemization” area, no movement or user intervention is required between these steps, and thus a prompt would be unnecessary. Thus, not only is there no deactivation prompt between the scanning and the tag deactivation, none would be necessary or wanted because no user input is required. It would be counterintuitive to prompt the user when no user intervention is required. The prompts disclosed in Mason’s embodiment in Col. 4, lines 16-19 of Mason happen after deactivation, and thus, they cannot be “deactivation prompts” and are not “presented prior to deactivation of the article” as claimed, *inter alia*, in Applicant’s claim 1. Thus Mason does not have every element of Applicant’s claim 1.

A 102(e) rejection can be overcome in the same ways a 102(b) rejection can be overcome. MPEP 2136.05. It is well established that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough that the cited reference discloses all the claimed elements in isolation, but the reference must disclose each element of the claimed invention “arranged as required by the claim.” (MPEP § 2131). As every limitation is required to be anticipated by §102, Applicant believe the rejection of claim 1 based on Mason is overcome in light of the above arguments.

Claims 5 and 7 have also been amended into Applicant’s claim 1 with a few additional amendments. In rejecting claim 5 under 35 U.S.C. § 103 as un-patentable over Mason, the Examiner re-stated his earlier rejection:

12. Claims 5 [is] rejected under 35 U.S.C. 103(a) as being unpatentable over mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases, as applied above in the rejection of claim 1 under 35 U.S.C. 102(e), but Mason fails to disclose that the database system coupled to the self-checkout station and comprising stored data identifying articles having attached security tags also stores data on articles not having attached security tags to determine whether an article designated by the received product code input has an attached security tag; and wherein the prompting system is configured to present the deactivation prompt when the article has an attached security tag and to not present the deactivation prompt when the article does not have an attached security tag, the system of Mason presenting the deactivation prompt when the stored data associated with an article does not indicate whether said article has an attached security tag or not, since the system of Mason seems to assume that all items in the store would have a security tag needing to be deactivated.

However, it is well known to those of ordinary skill in the art, that, ordinarily, due to the cost of the security tag, not all items in a store are provided with a security tag, and it would be self-evident/inherent that items not having security tags would not need to have a security tag deactivated.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Mason so as to use/store in the database of item weights, an indication as to whether or not each item is protected by a security tag, and to only deactivate tags for items that have such tags, as is well known to do, in order to accommodate stores having a mix of inventory partially protected by security tags and partially not protected by security tags, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected result.

The Examiner argues that it is well known that certain products would not have tags, and therefore concludes it would be obvious not to have to deactivate the tags. The Examiner then makes a leap and concludes that it would have been obvious “to have modified the system of Mason so as to use/store in the database of item weights, an indication as to whether or not each item is protected by a security tag”.

This is not so. The “deactivator 42” in Mason simply presents a static field that deactivates a tag. It does not need to determine whether to deactivate a tag depending on whether a tag is present or not. If no tag is in place, the deactivator 42 does not require unneeded attention, it simply provides a redundancy- an attempt to deactivate a tag that is not present. Since there is NO user input between bar code scanning and deactivation, and since there no reason to turn off the deactivator, it would not be obvious for one skilled in the art to include “a database system... comprising stored data identifying articles having attached security tags and articles not having attached security tag [and] a processor configured to receive product code input from the input device and to query the database to determine whether the article designated by said received product code input has an attached security tag”, as claimed, *inter alia*, in claims 1 and 16, **because it would be inconsistent for one skilled in the art to do so.** See *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1357 (Fed. Cir. 2007) (“While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation (‘TSM’) test in an obviousness inquiry, the Court acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does’ in an obviousness determination.”)

No reason can be present here to modify Mason to include the database/query limitation of Applicant’s claims, because no action is required while an item stays in the itemization area where it is scanned/deactivated. Applicant’s invention, in contrast, gains higher through-put time by having a user quickly move an item from scanner to deactivator to bagger, being interactively prompted all the way. In this invention, Applicant’s database and query system serves a purpose of increasing though put time even more **by allowing a user to skip a step when possible.**

Similarly, there is no reason for Mason to disclose alternating types of prompts claimed in Applicant’s claims 1 and 16, *inter alia*, “the prompting system is configured to present the deactivation prompt when the article has an attached security tag and to (i) not present the deactivation prompt and (ii) present a prompt to ignore the deactivation area, when the article does not have an attached security tag.” While Mason discloses audio or visual prompts to move an object from the itemization area to the itemized area, there are no alternating type prompts pending on the type of item purchased. Indeed, such alternating prompts are incompatible with Mason, as it is inconsistent with Mason to have different types of prompts regarding movement of items into the deactivation area when Mason does not require the user to induce any movement of items into the deactivation area.

More fundamentally, the concept of “a database system coupled to a self-checkout station and comprising stored data identifying articles having attached security tags and articles not having attached

security tags; a processor configured to receive product code input from the input device **and to query the database to determine whether the article designated by said received product code input has an attached security tag**” is an inventive step not present in the prior art reference put forth by the Examiner and cannot be simply declared as obvious ‘common knowledge’ without further support. To do so is impermissible hindsight. “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.” *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1797 (2007) (citing Graham, 383 U.S., at 36, 86 S. Ct. 684 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (6th Cir. 1964)))). The database/query/deactivation feature, as claimed by Applicant, does not exist in the prior art and is not compatible with the prior art, despite the fact that, as the Examiner notes, inventories of stores often have a mix of items with or without tags. For the Examiner to have reached his conclusion, it is respectfully submitted that he impermissible worked backward from Applicant’s invention.

Obviousness under §103 require one to look at (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of skill in the art; and (4) any relevant objective evidence of obviousness or non-obviousness.” *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). Since Mason does not have all of the features claimed by Applicant, and since one skilled in the art would not think to alter Mason to arrive at Applicant’s invention, Applicant’s claims 1 and 16 are allowable over §103.

#### **Other claims rejected under §102(e)**

Claim 3 of the present application is directed to a target visibly disposed proximate the deactivation region at the checkout station, wherein the second prompt instructs the user to move the article to touch the target to effect security tag deactivation. Contrary to the Examiner’s assertion, the system in Mason does not include a target visibly disposed proximate to the deactivation region, and it also does not include a second or any prompt to instruct or facilitate tag deactivation. Instead, the deactivation area in Mason is not separated or distinguishable from the scanning area, with both scanning and deactivation occurring automatically and without any prompts in the same area. The Examiner states that Mason discloses “a target 36 visibly disposed proximate the deactivation region...”, but in Mason,

the number '36' refers to the deactivation region itself. No target disposed proximate the deactivation region is disclosed.

Claim 11 of the present application teaches a prompting system configured to present a feedback prompt to confirm deactivation of the security tag after the sensor of the deactivation area senses presence of an article within the deactivation area. Contrary to the Examiner's assertion, Mason does not disclose any such prompting system, a feedback prompt, or a dedicated sensor for sensing the presence of an article within the deactivation area. The Examiner further did not specify where in Mason a teaching of the present application's claim 11's prompting system is found.

Claim 12 of the present application teaches a feedback prompt that further prompts a user to put an article for purchase in a bag. Contrary to the Examiner's assertion, Mason does not teach any feedback prompt that instructs a user to put an article for purchase in a bag. The Examiner further did not specify where in Mason a teaching of the present application's claim 12's prompting system is found.

Claim 14 of the present application teaches an animated prompt. Contrary to the Examiner's assertion, Mason does not teach an animated prompt of any sort, let alone one for deactivation. The Examiner further did not specify where in Mason a teaching of the present application's claim 14's prompting system is found.

Claim 15 of the present application teaches a prompting system where the deactivation prompt is by an audio device. Contrary to the Examiner's assertion, Mason does not a prompting system where the deactivation prompt is by an audio device. The Examiner further did not specify where in Mason a teaching of the present application's claim 15's prompting system is found.

For at least the reason that Mason fails to disclose or suggest one or more elements of claims 1-3 and 11-15, the Examiner's rejection of these claims for anticipation under 35 U.S.C. §102 in light of Mason is improper and should be withdrawn. Accordingly, it is respectfully requested that the Examiner withdraw his rejection and allow claims 1-3 and 7-15.

#### **Other rejections under §103**

The Examiner's rejection of claims 6, 8-10 and 16 under 35 U.S.C. § 103 as unpatentable over Mason is respectfully traversed.

It is well established that, to establish a *prima facie* case of obviousness, among other things, the combination of references must have all of the claimed limitations.

The Examiner did not appear to specify a rejection to claim 6 in his office action. Nonetheless, claim 6 of the present invention is believed allowable based on dependency on claim 1. Likewise claims 8-10 are believed allowable based on dependency to claim 1, either directly or through intervening claims.

### Conclusion

For the foregoing reasons, allowance of this application, as amended, is courteously urged. Amended claims 1-3, 6 and 8-16 are now pending and believed to be in condition for allowance.

If there remain any questions regarding the present application, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned at (212) 878-8429 in order for the undersigned to arrange for an interview with the Examiner.

Please charge any additional fees for this Amendment or credit any overpayments to Deposit Account No. 50-0521.

Respectfully submitted,



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